

REMARKS

The present communication is in response to the Official Action dated July 6, 2006, and is being submitted along with a Request for Continued Examination. Claims 1-12 and 23-52 are currently pending in the present application. The following sets forth Applicant's arguments relating to such claims.

In the Official Action, the Examiner has once again rejected claims 1-6, 8-12, 23-31, 33-45 and 47-52 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,608,898 to Volk ("Volk"), and claims 7, 32 and 46 under 35 U.S.C. § 103(a) as being obvious over Volk in view of U.S. Patent No. 6,796,986 to Duffner ("Duffner") and in further view of U.S. Patent 4,020,929 to Goldin ("Goldin"). Essentially, it is once again the Examiner's position that Volk teaches each of the limitations of claims 1-6, 8-12, 23-31, 33-45 and 47-52, while Duffner and Goldin obviate certain further limitations set forth in claims 7, 32, and 46 which Volk does not teach. With regard to Volk, the Examiner asserts that such reference discloses a first portion (29) able to be fixed with respect to a bone surface, a second portion (20) rotatably coupled to the first portion at pivot point (30) with a guide having guide surfaces (22, 23) and a means for positioning the first and second portions relative to each other. In addition, the Examiner asserts that the means for positioning the first and second portions relative to each other may be an arm (27) with a hole receiving a bolt or pin (36) and, being separate from the pivot point, the rotation of the first portion relative to the second portion maintains function if the first portion is attached to the bone. The Examiner also makes further assertions regarding the teachings of Volk, as well as those of Duffner and Goldin in light of certain additional limitations present in the depending claims to which they are applied.

In a previous Amendment submitted in the present matter, Applicant amended currently pending independent claims 1, 23, and 37 to include limitations which, in Applicant's opinion, overcame the Volk reference. Such limitations revolved around the present invention being capable of utilization during a bone resection procedure. In the Official Action, the Examiner notes his opinion that such arguments and amendments were unpersuasive. Specifically, the Examiner asserts that although Applicant contended that Volk is deficient because Volk does not disclose a plurality of bone fastener apertures, fasteners for connecting bone, and a resection guide for guiding a bone tool, the structure of the apertures, fasteners, and saw of Volk meet the structural limitations of the currently pending claims and are fully capable of meeting the intended use of the present invention. The Examiner specifically cites M.P.E.P. § 2114 as noting that functional intended use limitations are not limiting. Although Applicant agrees with the Examiner's application of the law, Applicant respectfully disagrees with the Examiner's interpretation of the Volk reference.

More particularly, Applicant is of the opinion that the structure taught in Volk would not be capable of use in resecting a bone, such as the distal portion of a femur or the proximal portion of a tibia. In this regard, Applicant notes that the structure set forth in Volk appears to be rather bulky and not specifically tailored to use within the body. For example, tabs 38, which the Examiner cites in connection with pins or screws as being means for connection or fixing to bone, seem to be an extension which would actually interfere with a surgical procedure such as the resection procedures noted above. The Volk reference is directed to a saw guide and miter apparatus, and tabs 38 are locator tabs whose spacing "defines a hand hold area where user of the assembly can grasp with one hand between the locator tabs 38 a workpiece 40 requiring

cutting and can hold the top of the workpiece with firm contact with the common bottom face of sector plate 29, protractor arm 27 and saw guide weight 20, while simultaneously firmly maintaining one longitudinal edge of the workpiece 40 against the locator tabs 38 which define a fence for the workpiece 40." See Volk, column 3, lines 41-49. In other words, locator tabs 38 of Volk are designed to abut a work piece (e.g. a piece of wood) and provide a fixed reference point for the remainder of the elements of Volk to be situated from. Their spacing also allows for a user to grip both the guide and the workpiece simultaneously during use. There is no discussion of Volk of such tabs being fixed to the work piece. In this regard, Applicant once again point outs that no fastener apertures whatsoever are taught by Volk for penetrating the workpiece, as holes in a wooden piece are undesirable since, unlike bone, holes in wood cannot heal.

Furthermore, there is also no discussion of Volk of the saw guide and miter apparatus being utilized in resection of a bone. In fact, locator tabs 38 would likely prevent proper positioning of the guide taught in Volk in any bone resection procedure. Specifically, where the present invention may be utilized in resecting the distal portion of a femur or the proximal portion of a tibia, the guide taught in Volk could not properly be aligned in order to perform such resections. Tabs 38 require a straight edge top align the guide of Volk properly. This is not present in bone, and the guide of Volk is specifically unsuitable for contacting the medial or lateral tibia or femur like the guide of the present invention is.

Finally, Applicant points out that the configuration of the guide taught in Volk would also make it more difficult in performing a resection of bone. Specifically, the element which the Examiner notes as arm (27) is far different from the means for positioning the first and second portions of the present

resection guide. Arm (27) of Volk provides for a bulkier guide that would likely require very small individual components in order to be utilized in the body. Ultimately, in Applicant's opinion, this would result in the guide of Volk being unusable during a bone resection procedure.

Thus, in light of the above, Applicant respectfully submits that the Volk reference is improperly utilized by the Examiner, and, as such, currently pending independent claims 1, 23, and 37 are not anticipated nor suggested by any of the prior art of record. Applicant respectfully requests that the rejections of such claims and the claims be moved into a condition of allowance. Similarly, given that the remaining pending claims in the present application are dependent claims properly depending upon either independent claim 1, 23, or 37, or an intervening dependent claim, allowance of currently pending claims 1-12 and 23-52 is also respectfully requested.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

Application No.: 10/757,619

Docket No.: OSTEONICS 3.0-480

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

By 

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